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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/283,542	04/01/1999	JAMES R. H. CHALLENGER	YO999-039-(8	1176

7590

09/11/2002

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EXAMINER

BASHORE, WILLIAM L

ART UNIT

PAPER NUMBER

2176

DATE MAILED: 09/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

JP

Office Action Summary

Application No.

09/283,542

Applicant(s)

CHALLENGER ET AL.

Examiner

William L. Bashore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. This action is responsive to communications: original application filed 4/1/1999.
2. Claims 1-22 are pending. Claims 1, 8, 15, 21, 22 are independent claims.

Specification

3. The disclosure is objected to because of the following informalities:

Regarding Specification page 10 lines 2-3, Attorney docket number should be deleted and replaced with "U.S. Patent Application No. 09/283,562 - currently pending".

Regarding Specification page 17 lines 4-5, Attorney docket number should be deleted and replaced with "U.S. Patent Application No. 09/283,561 – currently pending".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Regarding independent claim 15, the term "*efficient*" in claim 15 is a relative term which renders the claim indefinite. The term "*efficient*" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The Examiner's suggestion of deleting said term from said claim will overcome this rejection.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

the claimed invention is directed to non-statutory subject matter.

Regarding claims 1-7, and 21, the recited limitations in each of said claims can be interpreted as a series of mental/manual steps in combination (i.e. manually constructing chapters of a photo album, etc.), therefore is directed towards non-statutory subject matter. The Examiner's suggestion of amending the preambles in each said claim to recite "*a computer-executable method*" will overcome this rejection.

Examiner's Note

6. The following set of rejections are based upon a possible interpretation of a method as "*a computer-executable method*", and an efficient order as "*an order*".

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. **Claims 1-3, 5, 8-10, 12, 15, 17-18, 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gramlich, U.S. Patent No. 5,826,025 issued October 1998.**

In regard to independent claim 1, Gramlich teaches construction of a web document comprising merging of parts of a document with annotation overlay(s) provided by a user, or annotation server (Gramlich Abstract, column 2 lines 39-43; compare with claim 1 “*A method for constructing... comprising the steps of:*”, and “*providing at least one fragment*”). The limitation of “*a plurality of objects*” would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Gramlich, because Gramlich teaches multiple annotations as applied to document merging (Gramlich Figure 1), as well as serially connecting annotation files (Gramlich column 6 lines 49-57), suggesting a plurality of objects, providing Gramlich the benefit of annotations (fragments) indicative of various diverging commentary from different authors.

Gramlich teaches determining an order for inclusion of annotations within a document based upon the merged inclusion of Source 1 annotations only after inclusion of Source 2 annotations occur (Gramlich column 5 lines 52-67, especially column 6 lines 1-5, and lines 49-58). Gramlich also teaches pattern fields for parsing and processing patterns of words that the system must operate on in an ordered manner (Gramlich column 9 lines 19-34). Gramlich also teaches merging annotations in an order determined by the precedence of the associated operation (Gramlich column 11 lines 61-67). Compare with claim 1 “*determining an order... at least one fragment*”).

Gramlich teaches an Annotation Overlay Proxy (AOP) for constructing the merged web documents as described above (Gramlich column 5 lines 18-40; compare with claim 1 “*constructing the plurality of objects... for constructing the objects.*”).

In regard to dependent claim 2, Gramlich teaches determining an order for inclusion of annotations within a document based upon the merged inclusion of Source 1 annotations only after inclusion of Source 2 annotations occur (Gramlich column 5 lines 52-67, especially column 6 lines 1-5, and lines 49-58). Gramlich also teaches pattern fields for parsing and processing patterns of words that the system must operate on in an ordered manner (Gramlich column 9 lines 19-34). Gramlich also teaches merging annotations in an order determined by the precedence of the associated operation (Gramlich column 11 lines 61-67). Compare with claim 2.

In regard to dependent claim 3, Gramlich teaches determining whether an annotation directory contains overlays for the overlay groups specified a user, and to issue a message specifying the overlay groups not currently represented in said annotation directory (Gramlich column 11 lines 15-39; compare with claim 3).

In regard to dependent claim 5, the limitation of examining objects, rejecting based on content, and approving publication of remaining objects would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Gramlich, because Gramlich teaches an embodiment comprising a magazine model, where paid authors submit annotations to a centralized editor who then edits and publishes the author's overlays in groups manages by the editor (Gramlich column 8 lines 47-54; compare with claim 5), providing Gramlich with the suggested advantage of submitting annotations to a magazine editor with well known duties of editing, rejecting and accepting stories for publication.

In regard to independent claim 8, claim 8 reflects the apparatus comprising computer readable instructions used for performing the methods as claimed in claim 1, and is rejected along the same rationale.

In regard to dependent claims 9-10, 12, claims 9-10, 12 reflect the apparatus comprising computer readable instructions used for performing the methods as claimed in claims 2-3, 5 respectively, and are rejected along the same rationale.

In regard to independent claim 15, claim 15 reflects the system comprising computer readable instructions used for performing the methods as claimed in claim 1, and in further view of the following, is rejected along the same rationale.

Gramlich teaches an Annotation Overlay Proxy (AOP) which analyzes and parses documents that includes patterns (Gramlich column 5 lines 45-55, column 10 lines 60-63, column 11 lines 62-67; compare with claim 15 “*parser*”, “*analyzer*”, and “*constructor*”).

In regard to dependent claim 17, Gramlich teaches submission of annotations from users (Gramlich column 8 lines 40-54; compare with claim 17).

In regard to dependent claim 18, the limitation of a consistency checker for preventing publication of inconsistent objects would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Gramlich, because Gramlich teaches an embodiment comprising a magazine model, where paid authors submit annotations to a centralized editor who then edits and publishes the author’s overlays in groups manages by the editor (Gramlich column 8 lines 47-54; compare with claim 18), providing Gramlich with the suggested advantage of submitting annotations to a magazine editor with well known duties of rejecting stories for publication due to various inconsistencies.

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In regard to dependent claim 20, Gramlich teaches a system which merges annotation overlays ontop documents, resulting in a final HTML document (Gramlich column 6 lines 16-24; compare with claim 20).

In regard to independent claim 21, claim 21 incorporates substantially similar subject matter as claimed in claim 1, and is rejected along the same rationale.

In regard to independent claim 22, claim 22 reflects the apparatus comprising computer readable instructions used for performing the methods as claimed in claim 21, and is rejected along the same rationale.

9. **Claims 4, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gramlich, U.S. Patent No. 5,826,025 issued October 1998 in view of Arora et al. (hereinafter Arora) U.S. Patent No. 5,911,145 issued June 1999.**

In regard to dependent claim 4, Gramlich teaches an embodiment comprising a magazine model, where paid authors submit annotations to a centralized editor who then edits and publishes the author's overlays in groups manages by the editor (Gramlich column 8 lines 47-54) (suggesting the well known magazine editor duties of rejecting stories for publication due to various inconsistencies). Gramlich does not specifically teach delaying publication in response to a first object being non-existent. However, Arora teaches a "Don't Publish" button, giving the user the option of not publishing a Web page (Arora column 6 lines 17-24, column 9 lines 17-25; compare with claim 4). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Arora to Gramlich,

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providing the magazine editor of Gramlich the capability of not publishing Web documents due to various circumstances (i.e. past a deadline, etc.).

In regard to dependent claim 11, claim 11 reflects the apparatus comprising computer readable instructions used for performing the methods as claimed in claim 4, and is rejected along the same rationale.

10. **Claims 6, 13, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gramlich, U.S. Patent No. 5,826,025 issued October 1998 in view of Weinberg et al. (hereinafter Weinberg), U.S. Patent No. 6,144,962 issued November 2000.**

In regard to dependent claim 6, Gramlich does not specifically teach automatically detect broken hypertext links. However, Weinberg teaches a Web site visualization system whereby broken links are detected and automatically fixed (Weinberg Abstract near middle, column 18 line 24; compare with claim 6). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Weinberg to Gramlich's magazine embodiment, providing authors of Gramlich the capability of updating an author's information by detecting broken links within the annotation overlays to be merged with Web documents, keeping information current.

In regard to dependent claim 13, claim 13 reflects the apparatus comprising computer readable instructions used for performing the methods as claimed in claim 6, and is rejected along the same rationale.

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In regard to dependent claim 19, claim 19 reflects the system comprising computer readable instructions used for performing the methods as claimed in claim 6, and is rejected along the same rationale.

11. **Claims 7, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gramlich, U.S. Patent No. 5,826,025 issued October 1998 in view of Dozier et al. (hereinafter Dozier), U.S. Patent No. 5,870,552 issued February 1999.**

In regard to dependent claim 7, Gramlich does not specifically teach automatically detecting/updating objects. However, Dozier teaches publishing Web documents over a network, whereby content can be replaced regarding updating of a company logo, or a URL shared by many documents (Dozier column 8 lines 30-39, Figure 10b-10d; compare with claim 7). Since Dozier teaches a form for entering user comments with a logo (that can be automatically updated) (Dozier Figure 10c), it would have been obvious to one of ordinary skill in the art at the time of the invention to apply Dozier to Gramlich's magazine embodiment, providing authors of Gramlich the capability of updating an author's logo and/or URL within the annotation overlays to be merged with Web documents, to keep information current.

In regard to dependent claim 14, claim 14 reflects the apparatus comprising computer readable instructions used for performing the methods as claimed in claim 7, and is rejected along the same rationale.

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12. **Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gramlich, U.S. Patent No. 5,826,025 issued October 1998 in view of Shoham, U.S. Patent No. 5,855,015 issued December 1998.**

In regard to dependent claim 16, Gramlich does not specifically teach dependency graphs. However, Shoham teaches directed graphs for retrieving hyperlinked resources associated with resources added by authors (Shoham column 3 lines 1-10, column 6 lines 40-60, Figure 2; compare with claim 16). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Shoham to Gramlich, providing Gramlich the capability of directed dependency graphs to more efficiently retrieve hyperlinked resources.

Conclusion

13. **Prior art made of record and not relied upon is considered pertinent to disclosure.**

Merritt et al.	U.S. Patent No. 6,041,335	issued	03/2000
Fogg et al.	U.S. Patent No. 6,321,242	issued	11/2001
Sidana	U.S. Patent No. 5,890,170	issued	03/1999
Mangat et al.	U.S. Patent No. 6,049,799	issued	04/2000

Davis, Hugh C., Referential Integrity of links in open hypermedia systems, ACM Conference of Hypertext and Hypermedia, 1998, pages 207-216.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Bashore whose telephone number is (703) 308-5807. The examiner can normally be reached on Monday through Friday from 11:30 AM to 8:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

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15. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 746-7239 (for formal communications intended for entry)

or:

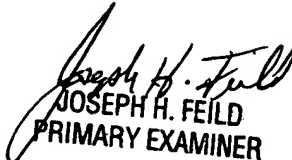
(703) 746-7240 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

or:

(703) 746-7238 (for after-final communications)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA, Fourth Floor (Receptionist).

William L. Bashore
09/07/2002


JOSEPH H. FEILD
PRIMARY EXAMINER